



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,895	12/30/2005	Alain Bejean	94176	9332

24628 7590 07/28/2010
Husch Blackwell Sanders, LLP
Husch Blackwell Sanders LLP Welsh & Katz
120 S RIVERSIDE PLAZA
22ND FLOOR
CHICAGO, IL 60606

EXAMINER

HENNING, MATTHEW T

ART UNIT	PAPER NUMBER
----------	--------------

2431

MAIL DATE	DELIVERY MODE
-----------	---------------

07/28/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/532,895	Applicant(s) BEJEAN, ALAIN	
	Examiner MATTHEW T. HENNING	Art Unit 2431	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-11 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1 This action is in response to the communication filed on 2/9/2010.

2 **DETAILED ACTION**

3 *Continued Examination Under 37 CFR 1.114*

4 A request for continued examination under 37 CFR 1.114, including the fee set forth in
5 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is
6 eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)
7 has been timely paid, the finality of the previous Office action has been withdrawn pursuant to
8 37 CFR 1.114. Applicant's submission filed on 2/9/2010 has been entered.

9
10 *Response to Arguments*

11 Applicant's arguments filed 2/9/2010 have been fully considered but they are not
12 persuasive.

13 First, applicant's arguments with respect to claims 13 and 2-7 are moot in view of the new
14 grounds of rejection presented below.

15 Regarding claims 8-11, the examiner notes that claim 8 as written is treated as an
16 independent claim. As such, the intended use recited in the preamble of the system claim has not
17 been given patentable weight because the limitation of the body of the claim can stand alone.

18 Therefore, the applicants' arguments are not found persuasive.

19 All objections and rejections not set forth have been withdrawn.

20 Claims 2-11 and 13 have been examined.

21

22

Information Disclosure Statement

The information disclosure statement(s) (IDS) submitted on 2/9/2010 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statements.

Priority

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 13 and 2-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Domenz et al. (US Patent Application Publication Number 2004/0177279), hereinafter referred to as Domenz.

A method of securing a learning mode of a device, the device including a secure first command transmitter and a command receiver, the command receiver being capable of driving an element providing for at least one of the security and the comfort of occupants of a building, the method comprising: providing at least one first activation function for switching the command receiver to the learning mode, the first activation function being associated with the

1 secure first command transmitter; providing at least one second activation function for switching
2 the command receiver to the learning mode, the second activation function being associated with
3 at least one of the command receiver, a second command transmitter, and a main power supply;
4 applying at least one action to the secure first command transmitter; the application of the at least
5 one action to the secure first command transmitter causing a disabling of the second activation
6 function for switching the command receiver to the learning mode; the disabling of the second
7 activation function preventing the command receiver from being switched to the learning mode
8 by the second activation function; and maintaining a capability of the secure first command
9 transmitter to switch the command receiver to the learning mode via the first activation function
10 after the disabling of the second activation function (Domenz Figs. 3-4 and Paragraph 0005).

11 Regarding claim 2, Domenz taught wherein the at least one action comprises at least a
12 first action that is undertook on at least one secure command transmitter and successively or
13 simultaneously at least a second action that is undertook on at least one other command
14 transmitter (Domenz Paragraph 0005).

15 Regarding claim 3, Domenz disclosed wherein the at least one action on the secure
16 command transmitter activates the learning mode of the receiver (Domenz Paragraph 0005).

17 Regarding claim 4, Domenz disclosed wherein the at least one action on the secure
18 command transmitter disables the at least one activation function of the learning mode with the
19 exception of the at least one activation function of the secure command transmitters (Domenz
20 Paragraph 0005).

21 Regarding claim 5, Domenz disclosed wherein the disabling of the activation function is
22 irreversible (Domenz Paragraph 0005).

1 Regarding claim 6, Domenz disclosed wherein the disabling of the activation function is
2 temporary (Domenz Paragraph 0005).

3 Regarding claim 7, Domenz disclosed wherein an action on a secure command
4 transmitter causes, in the memory of the receiver, the erasure of the identity numbers of at least
5 certain transmitters (Domenz Paragraph 0022).

6
7
8 Claims 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Heitschel et al.
9 (US Patent Number Re. 35,364) hereinafter referred to as Heitschel.

10
11 Regarding claim 8, Heitschel taught a device intended to implement the method as claimed in
12 claim 13, which device comprises at least one secure command transmitter (master transmitter),
13 and possibly other command transmitters, communicating with a command receiver capable of
14 driving an element providing for the security and/or the comfort of a building (Heitschel Col. 3
15 Line 60 – Col. 4 Line 22).

16 Regarding claim 9, Heitschel taught that the secure command transmitters comprise
17 wireless means of remote communication with the command receiver (Heitschel Col. 3 Line 60 –
18 Col. 4 Line 22).

19 Regarding claims 10-11, Heitschel taught that the secure command transmitters
20 have two dimensions small enough so that the secure command transmitters are capable of being
21 stored in a strongbox (Heitschel Fig. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over, and further in view of Bruwer (US Patent Number 6,191,701).

Regarding claim 12, Heitschel disclosed a method of securing the learning mode of a device (receiver), the device including an assembly of at least one command transmitter (transmitter) communicating with a command receiver, the command receiver capable of being switched to a learning mode by at least one activation function and the command receiver capable of driving an element providing for the security and/or the comfort of a building (Heitschel Abstract and Col. 3 Lines 41-59), the method comprising: applying at least one action to a device of the assembly (Heitschel Col. 3 Lines 41-59 Switching to the Operate Position on the receiver); but Heitschel did not disclose that the “action” was applied to a particular command transmitter of the assembly in order to disable the learning mode, or preventing the command receiver from being switched into the learning mode by the disabled activation function.

Bruwer, on the other hand, teaches that in order to improve the security of a programmable receiver (decoder), instead of activating the learning mode on the receiver, a

Art Unit: 2431

1 master transmitter (master encoder) can be used to set the learning mode on the receiver (Bruwer
2 Col. 7 Line 62 – Col. 8 Line 5), and after the learning mode is complete the master transmitter is
3 set back to normal mode, and subsequently the receiver is set to normal mode (Bruwer Col. 8
4 Line 55-63). Bruwer further teaches that the master transmitter learning mode can be disabled in
5 order to prevent the learning mode from being activated using the master transmitter (Bruwer
6 Col. 17 Line 45 – Col. 18 Line 4).

7 It would have been obvious to the ordinary person skilled in the art at the time of
8 invention to have employed the teachings of Bruwer in the garage door opener system of
9 Heitschel by providing a master transmitter which is used to switch between the operating mode
10 and the programming mode, and further providing that the learning mode of the master
11 transmitter be disabled after programming the receiver. This would have been obvious because
12 the ordinary person skilled in the art would have been motivated to improve the security of the
13 coding system.

14 Regarding claim 2, Heitschel and Bruwer taught that the at least one action comprises at
15 least a first action that is undertaken on at least one secure command transmitter and successively
16 or simultaneously at least a second action that is undertaken on at least one other command
17 transmitter (See Bruwer Col. 7 Line 62 – Col. 8 Line 5 and Heitschel Col. 3 Line 60 – Col. 4
18 Line 22).

19 Regarding claim 3, Heitschel and Bruwer taught that the at least one action on the secure
20 command transmitter activate the learning mode of the receiver (Bruwer Col. 7 Line 62 – Col. 8
21 Line 5).

Regarding claim 4, Heitschel and Bruwer taught that the at least one action on the secure command transmitter disables the at least one activation function of the learning mode with the exception of the at least one activation function of the secure command transmitters (See Bruwer Col. 7 Line 62 – Col. 8 Line 5 and Heitschel Col. 3 Line 60 – Col. 4 Line 22).

Regarding claim 5, Heitschel and Bruwer taught that the disabling of the activation function is irreversible (Bruwer Col. 7 Line 62 – Col. 8 Line 5).

Regarding claim 6, Heitschel and Bruwer taught that the disabling of the activation function is temporary (Heitschel Col. 3 Line 60 - Col. 4 Line 22).

Regarding claim 7, Heitschel and Bruwer taught that an action on a secure command transmitter causes, in the memory of the receiver, the erasure of the identity numbers of at least certain transmitters (Heitschel Col. 5 Lines 3-5).

Conclusion

Claims 2-11 and 13 have been rejected.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW T. HENNING whose telephone number is (571)272-3790. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on (571)272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2431

1 Information regarding the status of an application may be obtained from the Patent
2 Application Information Retrieval (PAIR) system. Status information for published applications
3 may be obtained from either Private PAIR or Public PAIR. Status information for unpublished
4 applications is available through Private PAIR only. For more information about the PAIR
5 system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR
6 system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would
7 like assistance from a USPTO Customer Service Representative or access to the automated
8 information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

9
10
11 /Matthew T Henning/
12 Primary Examiner, Art Unit 2431
13